

REMARKS/ARGUMENTS

Claims 1-40 are pending in the present application. In the Office Action mailed November 14, 2005, the Examiner rejected claims 1-4, 7, 8, 13-20, 23, 24, 29-35 and 37 under 35 U.S.C. § 102. The Examiner also rejected claims 5, 6, 9-12, 21, 22, 25-28, 36 and 38-40 under 35 U.S.C. § 103.

Claims 1, 7, 13, 23, and 29 have been amended. Claims 4, 5, 6, 20, 21, 22, 35, and 36 have been cancelled.

Reconsideration is respectfully requested in view of the above amendments to the claims and the following remarks.

A. Claims 1-4, 7, 8, 13-20, 23, 24, 29-35 and 37 Rejected Under 35 U.S.C. § 102(e)

The Examiner rejected claims 1-4, 7, 8, 13-20, 23, 24, 29-35 and 37 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,908,389 to Puskala (hereinafter, "Puskala"). This rejection is respectfully traversed.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP § 2131 (citing Verdegaal Bros. v. Union Oil Co. of California, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)). "The identical invention must be shown in as complete detail as is contained in the ... claim." Id. (citing Richardson v. Suzuki Motor Co., 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)). In addition, "the reference must be enabling and describe the applicant's claimed invention sufficiently to have placed it in possession of a person of ordinary skill in the field of the invention." In re Paulsen, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994). Applicants respectfully submit that the claims at issue are patentably distinct from Puskala. Puskala does not disclose all of the limitations in these claims.

Claim 1 has been amended to recite a hand-held wireless telecommunications device comprising an input component "wherein the input component is capable of entering text," "memory in electronic communication with the processor for storing data, wherein the data comprises at least one token," and "a messaging module ... implementing a method comprising ... providing to the user a message user interface to select a message from a plurality of preconfigured messages ...

wherein at least one of the messages is a text message that includes at least one token ... and wherein the messaging module allows the user to enter token text to replace the at least one token in the message.”

Claim 13 has been amended to recite a web site for editing and storing preconfigured messages to be used with hand-held wireless telecommunications devices comprising “a computer enabling operation of the web server ... implementing a method comprising ... sending a plurality of preconfigured messages ... wherein at least one of the preconfigured messages is a text message that includes at least one token, and wherein at least one token is editable by the user using the wireless device.”

Claim 29 has been amended to recite “a method for providing preconfigured messages to a hand-held wireless telecommunications device to be sent to a recipient through use of a global computer network, the method comprising:” “establishing electronic communication between the wireless device and a web site storing preconfigured messages ... wherein at least one of the messages is a text message that includes at least one token, and wherein at least one token is editable by the user using the wireless device” and “providing to the user a message user interface to select a message from the preconfigured messages, wherein if the message includes a token, the message user interface allows the user to input token text.”

Support for these amendments may be found in Applicants’ Specification on page 3, lines 10-12; page 9, line 28 through page 10, line 14; page 13, lines 25-28; cancelled claims 4, 5, 6, 20, 21, 22, 35, and 36; and Figure 6. Claims 7 and 23 were clarified in light of the amendments to claims 1 and 13 to recite “at least one message is an e-mail.”

Applicants submit that Puskala does not disclose the amended elements of claims 1, 13, and 29. In the Office Action, the Examiner admitted, “Puskala does not describe that the message is a text message that includes a token. Puskala further fails to describe that the messaging module allows the user to enter token text to replace the token in the message.” Office Action, pages 9-10. Applicants respectfully submit that they agree with the Examiner and in light of the above

amendments submit that independent claims 1, 13, and 29 are patentably distinct from Puskala. Accordingly, Applicants respectfully request that the rejection of these claims be withdrawn.

Claims 2, 3, 7 and 8 depend either directly or indirectly from claim 1. Claims 14-19 and 23-24 depend either directly or indirectly from claim 13. Claims 30-34 and 37 depend either directly or indirectly from claim 29. Accordingly, Applicants respectfully request that the rejection of claims 2, 3, 7-8, 14-19, 23-24, 30-34, and 37 be withdrawn for at least the same reasons as those presented above in connection with claims 1, 13, and 29.

B. Rejection of Claims 5, 6, 21, 22, and 36 Under 35 U.S.C. § 103(a)

The Examiner rejected claims 5, 6, 21, 22, and 36 under 35 U.S.C. § 103(a) based on Puskala in view of U.S. Publication No. 2002/0174106 to Martin (hereinafter, "Martin"). Because claims 5, 6, 21, 22, and 36 have been cancelled, this rejection is respectfully traversed. However, because the rejected claims have been cancelled and claims 1, 13, and 29 have been amended to recite the subject matter of these rejected and cancelled claims, this rejection will be applied to claims 1, 13, and 19 instead.

The M.P.E.P. states that

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.

M.P.E.P. § 2142.

The M.P.E.P. further states that “[a] prima facie case of obviousness may also be rebutted by showing that the art, in any material respect, teaches away from the claimed invention. M.P.E.P. § 2144.05 citing In re Geisler, 116 F.3d 1465, 1471, 43 USPQ2d 1362, 1366 (Fed. Cir. 1997). This is because “[i]t is improper to combine references where the references teach away from their combination.” M.P.E.P. § 2145 citing In re Grasselli, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983). The Federal Circuit has held that a reference teaches away from a claimed invention when the reference leads its reader “in a direction divergent from the path that was taken by the applicant.” Tec Air, Inc. v. Denso Mfg. Mich. Inc., 52 USPQ2d 1294, 1298 (Fed. Cir. 1999).

Applicants respectfully submit that the claims at issue are patentably distinct from the cited references. Because the references cannot be combined, the cited references do not teach or suggest all of the limitations in these claims.

As shown above, Puskala does not disclose, teach, or suggest that “at least one of the ... messages is a text message that includes at least one token,” as recited in claims 1, 13, and 29. Likewise, Puskala does not disclose that “the messaging module allows the user to enter token text to replace the at least one token in the message,” as recited in claim 1 or that “at least one token is editable by the user using the wireless device,” as recited in claims 13 and 29. However, Applicants respectfully submit that in addition to not disclosing, teaching, or suggesting these claim elements, Puskala teaches away from their inclusion or use. Therefore, because Puskala teaches away from these claim elements, Puskala cannot be combined with Martin to render claims 1, 13, and 29 unpatentable.

The Examiner’s asserted motivation to combine Puskala and Martin is that the combination “will enhance the editing and sending of the text messages.” Office Action, page 10. However, this assertion is in direct conflict with Puskala. Puskala discloses predefined messages for wireless multiplayer gaming. As discussed above, Puskala only discloses predefined messages, not the use of tokens, as recited in claims 1, 13, and 29. Puskala only discloses predefined messages, because the use of messages that are not defined before gameplay begins would interrupt the game.

For example, Puskala asserts that “[i]t is often difficult for a player to define a message to be sent while playing a game because the game often fills the entire relatively small display on the mobile terminal.” Puskala, col. 1, lines 43-46. Additionally, Puskala states that “using a portion of the display to prepare a message to be sent will cover a substantial portion, if not all, of the game screen, making it difficult or impossible to see the game while communicating.” *Id.* at lines 46-50. Furthermore, because mobile phones “usually only have numeric keypads and possibly a few special feature buttons that can be used to enter messages ... [e]ntering messages by typing on a keyboard can be a slow process and can interrupt the game.” *Id.* at lines 57-58. “Therefore, it is not only challenging to create games that can be played using mobile terminals but it is also challenging to find a simplified means for players to communicate before, during, or after the playing of the game.” *Id.* at lines 58-62. Consequently, “[w]here at least some of the messages are player-defined, it is preferable to define the messages at a time other than during the playing of a game so that it is not necessary to disrupt the game to create a message and to customize the messages that are sent.” *Id.* at col. 7, lines 38-42.

Puskala teaches away from any customization of messages during gameplay, because Puskala would lead one of skill in the art at the time the invention was conceived “in a direction divergent from the path that was taken by the applicant.” Because customization requires typing on a numeric keypad, which is “a slow process” that “can interrupt the game,” and because the “prepar[ing] a message to be sent will cover a substantial portion, if not all, of the game screen, making it difficult or impossible to see the game while communicating,” Puskala clearly teaches away from any customization of its predefined messages including the use of tokens as recited in claims 1, 13, and 29. Therefore, Puskala cannot be combined with Martin or any reference for the purpose of customizing predefined messages especially the use of tokens, as recited in claims 1, 13, and 29.

Further, it is well settled that if the proposed modification/combination would render one of the references unsatisfactory or inoperable for its intended purpose, then these references teach away from their combination and an obviousness rejection is improper. MPEP § 2143.01; In re Gordon, 221 USPQ 1125, 1127 (Fed. Cir. 1984) (holding that where the proposed

combination/modification would cause the device outlined by the reference to become inoperable for its intended purpose, then this modification is improper and cannot be made.)

The intended purpose of Puskala is to prevent interruptions to gameplay by using predefined messages. However, Applicants submit that the use of tokens, as shown above, would interrupt gameplay thereby rendering Puskala at least unsatisfactory for its intended purpose of preventing such interruptions. Therefore, in addition to being divergent from the teachings of Puskala, the use of tokens would also render Puskala unsatisfactory for its intended purpose. Consequently, Puskala teaches away from the Examiner's proposed combination.

In view of the foregoing, Applicants respectfully submit that independent claims 1, 13, and 29 are patentably distinct from the cited references. Accordingly, Applicants respectfully request that these claims be allowed.

Claims 2, 3, and 7-12 depend either directly or indirectly from claim 1. Claims 14-19 and 23-28 depend either directly or indirectly from claim 13. Claims 30-34 and 37-40 depend either directly or indirectly from claim 29. Accordingly, Applicants respectfully request that claims 2, 3, 7-12, 14-19, 23-28, 30-34, and 37-40 be allowed for at least the same reasons as those presented above in connection with claims 1, 13, and 29.

C. Rejection of Claims 9-12, 25-28, and 38-40 Under 35 U.S.C. § 103(a)

The Examiner rejected claims 9-12, 25-28, and 38-40 under 35 U.S.C. § 103(a) based on Puskala in view of U.S. Publication No. 2002/0178353 to Graham (hereinafter, "Graham"). This rejection is respectfully traversed.

As presented above, the M.P.E.P. states that

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed

combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.

M.P.E.P. § 2142.

Applicants respectfully submit that the claims at issue are patentably distinct from the cited references. The cited references do not teach or suggest all of the limitations in these claims.

As discussed above, Puskala does not disclose, teach, or suggest the use of tokens as recited in claims 1, 13, and 29. Likewise, Graham does not disclose, teach, or suggest the use of tokens. In fact, even if Graham did disclose, teach, or suggest the use of tokens, the proposed combination would be improper because Puskala teaches away from any customization of its predefined messages.

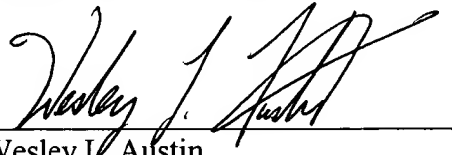
In view of the foregoing, Applicants respectfully submit that independent claims 1, 13, and 29 are patentably distinct from the cited references. Claims 9-12 depend either directly or indirectly from claim 1. Claims 25-28 depend either directly or indirectly from claim 13. Claims 38-40 depend either directly or indirectly from claim 29. Accordingly, Applicants respectfully request that the rejection of claims 9-12, 25-28, and 38-40 be withdrawn for at least the same reasons as those presented above in connection with claims 1, 13, and 29.

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Reply to Office Action of November 14, 2005

D. Conclusion

Applicants respectfully assert that all pending claims are patentably distinct from the cited references, and request that a timely Notice of Allowance be issued in this case. If there are any remaining issues preventing allowance of the pending claims that may be clarified by telephone, the Examiner is requested to call the undersigned.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Wesley L. Austin', written over a horizontal line.

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